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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 701,962	03.05.2001	Toshihisa Inoue	45455/250498	9837

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EXAMINER

QUASH, ANTHONY G

ART UNIT	PAPER NUMBER
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2881

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,962

Applicant(s)

INOUE ET AL.

Examiner

Anthony Quash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 March 2001 and 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 9, 10 6) ☐ Other _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: at least one pair of electrodes, one of the electrodes being to contact with a liquid sample, and the other being to contact with a reference liquid, a reservoir for the liquid sample and reference liquid. See applicant's specification, page 1, line 12- page 2, line 2. Claims 2-8 are rejected for depending on an indefinite base claim.

Claim 1 is indefinite since it is unclear as to which liquid reservoir the claim is referring to, the liquid sample reservoir or the reference liquid reservoir. Claims 2-8 are rejected for depending on an indefinite base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama [382]. As per claim 1, Maruyama [382] discloses an ion activity-measuring device Figs. 1-6 for measuring activity of an ion in a sample, which comprises a hydrophobic bridge 5 of which portion contacting with a liquid reservoir is hydrophilic. See Seto [740] col. 2-3 and claim 1.

As per claim 2, Maruyama [382] discloses the hydrophobic bridge 5 is produced from at least one selected from the group consisting of polyester, nylon, polypropylene, rayon and polyethylene. See Seto [740] col. 2, lines 1-26.

As per claim 3-4, Maruyama [382] disclose all the stated limitations. See Seto [740] col. 2-3 and claim 5.

Claims 1-2 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Seto [740]. As per claim 1, Seto [740] discloses an ion activity-measuring device Figs. 1-2 for measuring activity 20 of an ion in a sample, which comprises a hydrophobic bridge 600 of which portion contacting with a liquid reservoir is hydrophilic. See Seto [740] col. 3, lines 10-62, col. 4, line 40-col. 5, line 20.

As per claim 2, Seto [740] discloses the hydrophobic bridge 5 is produced from at least one selected from the group consisting of polyester, nylon, polypropylene, rayon and polyethylene. See Seto [740] col. 5, lines 15-20.

As per claim 5, Seto [740] discloses the liquid reservoir 70/72 is formed by bonding a cover plate and a substrate, at least one of which has a resist film having a

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liquid reservoir form, and the hydrophobic bridge is made of nonwoven fabric. See Seto [740] col. 5, lines 1-10 and col. 6, line 43-col. 7, line 40.

As per claim 6, Seto et al. disclose embedding nonwoven fabric in the cover plate to bond the nonwoven fabric to the cover plate. See Seto [740] Fig. 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seto [740]. Seto [740], as applied to claims 1, 2, 5 and 6 above, teaches all the stated limitations except the types of bonding used to bond the nonwoven fabric and the cover plate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the two elements together using various bonding techniques, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

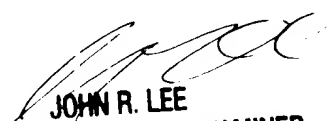
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Quash whose telephone number is (703)-308-6555. The examiner can normally be reached on M-F from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee, can be reached on (703)-308-4116. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0956.



A. Quash 9/30/02



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